REMARKS

Summary of Office Action

Claims 16, 17, 21-23, 29 and 30 are withdrawn from consideration.

Claims 18, 19, 26 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 11-13, 15, 18-20 and 24-27 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by McAtee et al., US 2002/0009484 (hereafter "McATEE") as allegedly evidenced by Patel et al., U.S. Patent No. 6,569,463 (hereafter "PATEL").

Claims 11-15, 18-20 and 24-28 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McATEE (as allegedly evidenced by PATEL) in view of Verdrel-Lahaxe et al., U.S. Patent No. 6,752,998 (hereafter "VERDREL").

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested, in view of the following remarks.

Response to Rejection under 35 U.S.C. § 112, First Paragraph

Claims 18, 19, 26 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The rejection essentially alleges that (merely) because the present specification does not point out specific examples of surfactants having an HLB value of greater than 25 the rejected claims contain subject matter which was not described in the specification in such a way

as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully traverse this rejection. In particular, the only reason why the present specification does not specifically point out examples of surfactants having an HLB value of greater than 25 is that one of ordinary skill in the art knows which surfactants have an HLB value of greater than 25. See, for example, U.S. Patent No. 4,988,567 (Delgado) entitled "HOLLOW ACID-FREE ACYLATE POLYMERIC MICROSPHERES HAVING MULTIPLE SMALL VOIDS" and filed in 1990 which states in the passage from col. 6, line 65 to col. 7, line 13 (emphasis added):

> In general, high HLB emulsifiers are required, i.e., emulsifiers having an HLB value of at least about 25, will produce stable cavity-containing droplets during the polymerization, and are suitable for use in this one-step process. Examples of such emulsifiers include alkylarylether sulfates such as sodium alkylarylether sulfate, e.g., Triton™ W/30, available from Rohm and Haas, alkylarylpolyether sulfates such as alkylarylpoly(ethylene oxide) sulfates, preferably those having up to about 4 ethyleneoxy repeat units, and alkyl sulfates such as sodium lauryl sulfate, ammonium lauryl sulfate, triethanolamine lauryl sulfate, and sodium hexadecyl sulfate, alkyl ether sulfates such as ammonium lauryl ether sulfate, and alkylpolyether sulfates such as alkyl poly(ethylene oxide) sulfates, preferably those having up to about 4 ethyleneoxy units.

In this regard, it is noted that a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Accordingly, the Examiner's apparent assumption that Applicants did not specifically point out in their specification which of the surfactants set forth therein have

an HLB value of greater than 25 allegedly is an indication that Applicants were not in possession (had no knowledge) of corresponding surfactants is clearly without merit.

Applicants submit that for at least the foregoing reasons, the rejection of claims 18, 19, 26 and 27 under 35 U.S.C. § 112, first paragraph, is unwarranted and should be withdrawn, which action is respectfully requested.

Response to Rejection under 35 U.S.C. § 102(b)

Claims 11-13, 15, 18-20 and 24-27 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by McATEE as allegedly evidenced by PATEL. The rejection essentially alleges that McATEE discloses all of the elements which are recited in the rejected claims, including a surfactant having an HLB value of at least 25 as allegedly evidenced by PATEL which shows that sodium lauryl sulfate has an HLB value of 40.

Applicants respectfully traverse this rejection as well. In particular, it is pointed out that present independent claim 11 is drawn to a substrate which impregnated with a cosmetic preparation comprising

(i) one of more salts of fatty acids having 8 to 20 carbon atoms per molecule; and

(ii) one or more surfactants.

Dependent claim 20 recites that the cosmetic preparation comprises (iii) one or more polysorbates.

It is pointed out that even if one were to assume, *arguendo*, that all of the above components (i) to (iii) are individually disclosed in McATEE, this document does not disclose these components in combination (arranged as in the rejected claims) and for this

reason alone, McATEE is unable to anticipate the subject matter of any of claims 11-13, 15, 18-20 and 24-27.

In this regard, Applicants specifically direct the Examiner's attention to NetMoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359 (Fed. Cir. 2008). Relevant portions of this decision are reproduced below for the Examiner's convenience (underlining in original, bold face provided):

> The district court, after finding all five of these links in the iKP reference, albeit in two separate disclosed examples, concluded that claim 23 was anticipated under 35 U.S.C. § 102(a) and therefore invalid. Specifically, the district court concluded:
>
> > All of the limitations of claim 23 can be found within the iKP reference. A simple combination would produce the system described in claim 23 of the '737 patent. That no specific example within iKP contains all five links does not preclude a finding of anticipation.
>
> Summary Judgment Decision at 3. NMI contends that the district court's combination of two disclosed examples in order to find all elements of the claim was erroneous. VeriSign responds that the district court did not improperly rearrange the links in the iKP reference, but rather "merely relied on various express teachings from a single document that together completely disclose the five claimed links." Appellees' Br. at 61. Under VeriSign's theory, this was sufficient to establish anticipation, because all that is required is "that the four corners of a single, prior art document describe every element of the claimed invention." Id. at 61-62 (quoting Xerox Corp. v. 3Com Corp., 458 F.3d 1310, 1322 (Fed. Cir. 2006)). We disagree with VeriSign, and take this opportunity to clarify what a reference must show in order to anticipate a claimed invention.
>
> Section 102(a) provides that an issued patent is invalid if "the invention [therein] was . . . described in a printed publication . . . before the invention thereof by the applicant." Section 102 embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is "anticipated" by the prior invention. As we have stated numerous times (language on which VeriSign relies), in order to demonstrate anticipation, the proponent must show "that the four corners of a single, prior art document describe every element of the claimed invention." Xerox, 458 F.3d at 1322 (quoting Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000)). This statement embodies the requirement in section 102 that the anticipating invention be "described in a printed publication," and is, of course, unimpeachable. But it does not tell the whole story. Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements

"arranged as in the claim." Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983).

The meaning of the expression "arranged as in the claim" is readily understood in relation to claims drawn to things such as ingredients mixed in some claimed order. In such instances, a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate, because the reference would be missing any disclosure of the limitations of the claimed invention "arranged as in the claim." But the "arranged as in the claim" requirement is not limited to such a narrow set of "order of limitations" claims. Rather, our precedent informs that the "arranged as in the claim" requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. **The test is thus more accurately understood to mean "arranged or combined in the same way as in the claim."**

For example, in Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452 (Fed. Cir. 1984), we reviewed a district court's determination that a patent directed to a hydraulic scrap shearing machine was anticipated by a prior patent directed to a method for shearing spent nuclear fuel bundles. Because the district court had "treated the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning," we reversed. Id. at 1459. Although the prior art reference could be said to contain all of the elements of the claimed invention, it did not anticipate under 35 U.S.C. § 102 because it "disclose[d] an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently." Id. at 1458. The reference thus was deficient because it did not disclose the elements of the claimed invention "arranged as in the claim" as required by 35 U.S.C. § 102. Id.

In Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361 (Fed. Cir. 2000), we reviewed a district court's decision that a prior art reference directed to "Saving Energy by Catalytic Reduction of Oxygen in Feedwater" anticipated a claim reciting the use of hydrazine with a mixed resin bed to deoxygenate water. In finding that the reference anticipated the claim, the district court considered a figure and accompanying text, which taught the use of hydrogen with a mixed bed to deoxygenate water, in conjunction with a separate passage discussing deoxygenating water with, among other things, hydrazine. Id. at 1369. We reversed. After determining that the relevant figure and accompanying text described only the use of hydrogen to deoxygenate water, we concluded that the reference could not anticipate the claimed invention because there was no link between that figure and the general discussion of hydrazine as a deoxygenating agent. Id. In other words, we concluded that although the reference taught all elements of the claim, it did not contain a discussion suggesting or linking hydrazine with the mixed bed in the figure, and thus did not show the invention arranged as in the claim.

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In all of these cases, the prior art reference had to show the claimed invention arranged or combined in the same way as recited in the claim in order to anticipate. We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Here, the iKP reference discloses two separate protocols for processing an Internet credit card transaction. Neither of these protocols contains all five links arranged or combined in the same way as claimed in the '737 patent. Thus, although the iKP reference might anticipate a claim directed to either of the two protocols disclosed, it cannot anticipate the system of claim 23. The district court was wrong to conclude otherwise.

Applicants submit that for at least all of the foregoing reasons, the rejection of claims 11-13, 15, 18-20 and 24-27 under 35 U.S.C. § 102(b) over McATEE as allegedly evidenced by PATEL is without merit, wherefore withdrawal thereof is respectfully requested.

Response to Rejection under 35 U.S.C. § 103(a)

Claims 11-15, 18-20 and 24-28, i.e., all claims under consideration, are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McATEE (as allegedly evidenced by PATEL) in view of VERDREL. The rejection is apparently based on the assumption that McATEE anticipates the subject matter of claims 11-13, 15, 18-20 and 24-27 and essentially alleges that the element that is not mentioned in McATEE, i.e., potassium stearate as an example of a soap of a fatty acid (recited in instant dependent claims 14 and 28), is disclosed in VERDREL, wherefore it would allegedly have been obvious to one of ordinary skill in the art to use potassium stearate for making an article according to the teaching of McATEE.

This rejection is respectfully traversed as well. In particular and as discussed above, the assumption that McATEE anticipates the subject matter of claims 11-13, 15, 18-20 and 24-27 is incorrect, and for this reason alone, the present rejection is without merit.

It further is pointed out again that McATEE clearly fails to teach or suggest a combination of components (i) and (ii) (let alone a combination of components (i) and (ii) and one or more polysorbates as recited in claim 20) for making the cleansing articles disclosed therein. Neither does McATEE prompt one of ordinary skill in the art to use of one or more surfactants having an HLB value of greater than 25 (let alone an HLB value greater than 35) as recited in some of the instant dependent claims.

In particular, it is pointed out again that the only mentioning of salts of fatty acids appears to be in paragraph [0116] of McATEE. This passage mentions salts of fatty acids without mentioning any specific fatty acid and merely as "[o]ther anionic materials useful herein". Other indications that salts of fatty acids are not considered particularly well suited for the purposes of the invention of McATEE are the fact that these salts are not included in the long list of preferred anionic lathering surfactants set forth in paragraph [0122] of McATEE (let alone in the list of especially preferred anionic surfactants in paragraph [0123] thereof or the long list of preferred lathering surfactants in paragraph [0148] thereof) and the fact that in none of the numerous exemplified compositions of McATEE any salts of fatty acids are employed. Accordingly, McATEE fails to prompt one of ordinary skill in the art to use one or more surfactants in combination with salts of fatty acids comprising from 8 to 20 carbon atoms per molecule for the cleansing articles of McATEE. VERDREL clearly is unable to cure the noted deficiencies of McATEE,

even if one were to assume, *arguendo*, that one of ordinary skill in the art would be motivated to combine the teachings of McATEE and VERDREL.

Applicants note that in response to the above arguments the Examiner merely alleges that these arguments are unpersuasive "because the salts of fatty acids are simple soaps (see [0116]), which are well-known to be used in cleansing articles for skin or hair (see McATEE's title)." Page 7, first paragraph of the instant Office Action.

It is submitted that from the quoted comments it appears that the Examiner is confusing consumer articles such as bar soaps or liquid soaps (which may be considered to be well-known cleansing articles for skin or hair) with "soaps" in a strictly chemical sense. In particular, paragraph [0116] of McATEE states (emphasis added):

> [0116] Other anionic materials useful herein are soaps (i.e., alkali metal salts, e.g., sodium or potassium salts) of fatty acids, typically having from about 8 to about 24 carbon atoms, preferably from about 10 to about 20 carbon atoms. The fatty acids used in making the soaps can be obtained from natural sources such as, for instance, plant or animal-derived glycerides (e.g., palm oil, coconut oil, soybean oil, castor oil, tallow, lard, etc.) The fatty acids can also be synthetically prepared. Soaps are described in more detail in U.S. Pat. No. 4,557,853, cited above.

Accordingly, McATEE refers not merely to "soaps" but to soaps (i.e., alkali metal salts) of fatty acids. In other words, the "soaps" of paragraph [0116] of McATEE are alkali metal salts of fatty acids, not consumer articles such as bar soaps or liquid soaps (which usually contain many different types of components). At any rate, the Examiner has not provided any evidence which could be considered to support an allegation that alkali metal salts of fatty acids "are well-known to be used in cleansing articles for skin or hair".

Applicants submit that for at least all of the foregoing reasons, McATEE in view VERDREL fails to render obvious the subject matter of any of the claims under

consideration, wherefore withdrawal of the instant rejection under 35 U.S.C. § 103(a) is respectfully requested as well.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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